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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,324	04/14/2000	John Slaby	491.040US1	8731
21186	7590	07/09/2004	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			POLLACK, MELVIN H	
		ART UNIT	PAPER NUMBER	
		2141	17	
DATE MAILED: 07/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/550,324	SLABY ET AL.
	Examiner Melvin H Pollack	Art Unit 2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 12 May 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 69-112,114-120,122-127,129,132 and 135 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 69-112,114-120,122-127,129,132 and 135 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>13</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)       |
|   | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 May 2004 has been entered.

#### *Priority*

2. Applicant's claim for priority under 35 U.S.C. 120 (claim of benefit – continuation – of a PCT) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support for claims 69-135 of this application. In order to be granted priority, the applicant must submit proof of codependency with an international application. In order to perfect priority, the applicant also needs to submit a certified copy of the PCT. Please refer to MPEP 1895, 1896, and 35 USC 120.

3. Applicant's arguments filed 12 May 2004 have been fully considered but they are not persuasive. A description of the reasoning follows.

4. Applicant has amended the claims, resulting in a change of scope, to clarify that the communications apparatus accesses at least one service system, thus showing that the two systems are separate. That said, it is clear that the purpose of Farese is to allow a User terminal to get a communications apparatus (the switch) to access a remote service (Fig. 1, #70: Host1). And it has further been shown that this is performed by use of a remote second communications apparatus (Broker PC). Therefore, the applicant has failed to amend around the art.

5. The applicant argues that the examiner fails to show that a remote second communications apparatus that is remote to both the first communications apparatus and the remote service. The examiner disagrees, and points to Fig. 1 as evidence, as all four items are clearly separated by some form of network, be it ISDN line or LAN line.

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the unique identification information cannot be transmitted to either configuration system, especially from the service system (P. 19, lines 9-12)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. A service system separate from, say the second configuration system, simply means that they are not located on the same computer, i.e a configuration server and an application server on the same mainframe. The claims do not expressly state that either communications system is barred from communications before the acceptance of unique identification information, nor do the claims expressly state the location of the unique identification information, nor do the claims expressly state that one apparatus may access the service without going through the other apparatus. The examiner recommends that the applicant amend the claims to address these issues.

8. Applicant also claims that Farese does not expressly disclose using the login information to generate any configuration data. As is clear in Farese, and is well-known in the art, login information is crucial to establishment of a connection, and thus to its subsequent configuration, and therefore leads to the development of configuration data. Furthermore, the use of such data

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also leads to choices in path access and other configuration data choices (col. 7, line 10 – col. 8, line 30). It is advised that the applicant amend the claim to clarify what the resulting configuration data is or how it is used.

9. In response to applicant's argument that Ashton is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Ashton teaches the monitoring and controlling of configuration apparatus in networks, as shown before, and as shown in the abstract. Therefore, the art is analogous.

10. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ashton is used as a more powerful monitoring system in order to facilitate the management of a network. This is something that Farese clearly could use, particularly in the case of monitoring and reacting to communications traffic (col. 6, lines 35-55). Therefore, at the time the invention was made, one of ordinary skill in the art would have used an Ashton monitoring system in Farese in order to make Farese more management friendly (col. 2, lines 14-33).

11. Applicant claims that Farese does not expressly disclose a clock to control the processor. The examiner responds that the limitation is inherent, as it would be impossible, or at least unlikely, for a processor to function without a clock, either in a switch or in a PC. Further, it is clear that the processors move from state to state, and that certain tasks are performed at certain times, thus making a clock further implicit. The applicant is advised to clarify the function of the clock, and its interaction with the rest of the system.

12. Applicant claims that Farese does not expressly disclose configuring for a plurality of reconfigurable devices. The claim as currently drawn means only that one or more computers are configured, and does not clarify whether the devices are of the same type or of a different type. Further, there are no limitations relating to the method of configuring devices of different types, i.e. a limitation in which a device type configuration information is sent and processed, nor is there evidence that the process for type A would necessarily have to be different from the process of type B. The applicant is advised to amend the claims to address these limitations.

13. The examiner notes that claims 114-135 have a much broader scope than claims 69-112. While this is acceptable, the examiner feels that narrower versions of these claims may expedite prosecution.

14. For the reasons above, the rejection stands.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 69-71, 75-78, 80-88, 91, 92 are rejected under 35 U.S.C. 102(e) as being anticipated by Farese et al. (4,996,685).

17. For claim 69, Farese teaches a method (see abstract) of remotely configuring communication apparatus (col. 1, lines 10-16) for communication over a network to access at least one service system (Fig. 1), the method comprising the steps of:

- a. Connecting said communication apparatus (Fig. 1, #30) to said network (Fig. 1, #35);
- b. Said communication apparatus automatically communicating with a remote configuration system over said network (Fig. 1, #50) using initial configuration data (Fig. 4, #430);
- c. Said communication apparatus transmitting unique identification information to said configuration system (Fig. 4, #490);
- d. At said configuration system determining configuration data for said communication apparatus (Fig. 4, #490, and Fig. 5, #503-507);
- e. Transmitting said configuration data to said communication apparatus (Fig. 5, #503-507);
- f. Storing said configuration data received from said configuration data in storage means in said communication apparatus (Fig. 6, #620-630);
- g. Controlling subsequent communications by said communication apparatus over said network to access a said service system (Fig. 1, #70) using the stored configuration data (Fig. 6);

- h. Transmitting subsequent configuration data to said communication apparatus automatically from said configuration system (Fig. 4-7);
- i. Storing said subsequent configuration data in said storage means (Fig. 7, #730-740); and
- j. Controlling subsequent communications by said communication apparatus over said network to access a said service system (Fig. 8) in accordance with the stored subsequent configuration data (Fig. 6 and 7).

18. As for claim 70, Farese also teaches a user (Fig. 1, #20) that initiates the process (Fig. 2, #213).

19. Claim 71 is drawn to the use of a permanently open control channel associated with a plurality of data/voice channels (col. 1, lines 20-45).

20. For claims 75-78, Farese teaches that the network connects a LAN (Fig. 1, #60) to an ISDN line (Fig. 1, #25 and #35) that has a data channel and a plurality of bearer channels (col. 1, lines 27-46).

21. Claim 80 is drawn to a means implementation of many of the limitations in claim 70. If claim 70 is rejected, so is claim 80.

22. As for claims 81-83, Farese teaches that there is a dedicated data channel (D channel) for receiving configuration data (col. 8, lines 19-22).

23. Claims 84-86 are drawn to processing means that implement the limitations drawn in claims 72-74, respectively. If claims 72-74 are rejected, then claims 84-86 are also rejected for the reasons above.

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24. As for claims 87 and 88, Farese teaches that the user I/O is a software program (Fig. 2A, #213).

25. As for claims 91 and 92, Farese teaches the encoding of the unique identification information (col. 21, lines 14-17) and the decoding of the configuration data (col. 21, lines 40-65). Examiner notes that encode and decode are not necessarily synonyms for encrypt and decrypt.

***Claim Rejections - 35 USC § 103***

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 72-74, 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farese as applied to claims 69-71, 75-78, 80-88, 91, 92 above, and further in view of Ashton et al. (6,181,679).

28. For claims 72-74, Ashton teaches the monitoring of such a network in real time (Fig. 4) and the processing of the information (Fig 9) into a summary report (Fig. 10). This report is then sent to the network manager (col. 2, lines 20-34), which could be the provider or the user as currently drawn in the claims. At the time the invention was made, one of ordinary skill in the art would have recognized that the network in Farese requires such a monitoring system (col. 2, lines 14-20).

29. As for claim 90, Ashton teaches that the information is gathered and processed using machine independent instructions for output to said user (col. 16, lines 53-56). At the time the

invention was made, one of ordinary skill in the art would have kept the system machine independent in order to support a wider variety of machines.

30. Claims 79, 89, 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farese as applied to claims 69-71, 75-78, 80-88, 91, 92 above, and further in view of Bhatia et al. (6,118,768).

31. As for claims 79 and 93, Bhatia teaches a connection of a POTS line (col. 15, lines 25-53). At the time the invention was made, one of ordinary skill in the art would have connected such a line to Farese in order to attach telephone equipment (Fig. 1, #20 and #25).

32. As for claim 89, Bhatia also teaches the use of a web server (Fig. 18 and 19). At the time the invention was made, one of ordinary skill in the art would have used a web server as a means of processing (col. 5, lines 1-10) as this was a standard method of I/O communication.

33. Claims 94-112, 114-120, 122-127, 129, 132, and 135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farese, Ashton, and Bhatia.

34. Claims 94-104 are drawn to a communication apparatus that implements the method drawn in claims 69, 80-82, 84-86, 88, 90-92, respectively. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claims 69, 80-82, 84-86, 88, and 90-92 are rejected, then claims 94-104 are also rejected for the reasons above.

35. As for claims 105 –109, Farese teaches that the configuration data is selected based on the unique identification information, the previously gathered and stored user information, and the requested level of service (Fig. 4-7).

36. Claims 110-112 are drawn to a communication apparatus that implements the method drawn in claims 90-92, respectively. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claims 90-92 are rejected, then claims 110-112 are also rejected for the reasons above.

37. Claim 114 is drawn to a system implementation of some of the limitations in claims 69, 73, 75 and 85. Claim 115 is drawn to a system implementation of claims 74 and 86. Claims 116-120 are drawn to a system implementation of claims 87-90, respectively. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claims 90-92 are rejected, then claims 114 and 115 are also rejected for the reasons above.

38. Claims 122-126 are yet another system implementation of claims 69, 85, 72, 88, 90, 105, respectively. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claims 69, 72, 85, 88, 90, and 105 are rejected, then claims 122-126 are also rejected for the reasons above.

39. Claims 127 and 129 are drawn to an independent method form of claims 72-74, respectively. If claims 72-74 are rejected, then claims 127 and 129 are also rejected for the reasons above.

40. Claims 132 and 135 are system means claim for certain parts of claim 69. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claim 69 is rejected, then claims 130-135 are also rejected for the reasons above.

***Conclusion***

41. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (703) 305-4641. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP  
19 June 2004



RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER